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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,422	03/29/2001	Roman Waupotitsch	888124-10	9404

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CUPERTINO, CA 95014

EXAMINER

SHAAWAT, MUSSA

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,422

Applicant(s)

WAUPOTITSCH ET AL.

Examiner

Mussa A Shaawat

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>29 March 2001</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This action is responsive to application # 09/823,422 filed on March 29, 2001. Claims 1-34 are presented for examination.

#### *Drawings*

1. The drawings are objected to because of the following informalities. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Figures 6C, 6D, and 6E are to be labeled as 600.

Figure 8 is to be labeled as 800.

Figure 9 is to be labeled as 900.

Figure 6C – The leader/pointer for reference number 624 points to the “OFF” position and does not match with the description in the specification (page 27, lines 9 and 12).

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

Figure 6E – Reference character 640 is not described in the specification.

Figure 8 – Reference character 810 is not described in the specification.

Figure 9 – Reference character 908 is not described in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Specification*

3. The disclosure is objected to because of the following informalities.

Appropriate correction is required.

4. Page 12, line 9 and 10: the reference character “108” should be changed to read “104”.
5. Page 19, line 3: the reference character “407” is not shown on figure 4. It appears that it should be “408”.

6. Page 19, line 23: the description of the reference character 407 does not match with figure 4.

***Claim Interpretation***

7. Claims 1-3, 9, 18-21, and 32 - The term "the glasses" is interpreted as being "pairs of eyeglasses".

***Claim Objections***

8. Claim 6 is objected to because of the following informalities: In claim 6 line 2 there is grammatical mistake and it should read, ..."so that the request can be transported..." Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. The term "substantially" in claim 14 is a relative term, which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear whether the request conforms fully or partially. The specification lacks some standard for measuring the degree intended. Ex parte Oetiker, 23 USPQ2d 641 (Bd. PA&I. 1992).

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. The claimed invention is directed to non-statutory subject matter. The claims 29-34 are non-statutory and are rejected. Claims recite a program. Per se, not tangibly embodied on a computer readable medium so as to be executable. The suggestion to over come the rejection would be to rewrite the claim to read "...the software product on a computer readable medium executable on a computing device".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1-34 rejected under 35 U.S.C. 102(b) as being anticipated by Pierre N. Fay US Patent No. (5,983,201) referred to hereinafter as Fay.

3. As to claim 1, Fay teaches a method for commercializing pairs of eyeglasses over a network, the method comprising, see Fay (col.2 lines 50-60): providing an interactive platform that can be displayed on a computing device, see Fay (col.4 lines 64-67, and col.5 lines 1-7); requesting a 3D face model from a user, see Fay (col.5 lines 7-20, col.8 lines 6-20); determining characteristics of the 3D face model with respect to a 3D reference frame, see Fay (col.5 lines 7-24, col.7 lines 45-58, col.8 lines 46-63); retrieving a 3D representation of a pair of eyeglasses when a request identifying the pair of eyeglasses is received over the network, see Fay (col.6 lines 18-34, col.8 lines 64-67, and col.9 lines 1-4); and placing the 3D representation of the glasses onto a default position with respect to the 3D face model in accordance with the characteristics thereof, see Fay (col.5 lines 55-67, col.8 lines 30-63).

4. As to claim 2, Fay teaches a method of claim 1 further comprising: permitting a relative interaction between the 3D representation of the glasses and the 3D face model, see Fay (col.8 lines 1-63, col.5 lines 55-67).

5. As to claim 3, Fay teaches a method of claim 1 further comprising: permitting a view of the 3D face model with the 3D representation of the glasses on from a chosen perspective, see Fay (col.8 lines 30-40).

6. As to claim 4, Fay teaches a method of claim 1, wherein the interactive platform includes respective displays of the pairs of eyeglasses so that the user can choose one therefrom, see Fay (col.6 lines 4-35, col.7 lines 15-45).

As to claim 5, Fay teaches a method of claim 4, wherein the request is generated on the computing device when one of the pairs of eyeglasses is selected, see Fay (col.6 lines 5-17).

7. As to claim 6, Fay teaches a method of claim 5, wherein the request conforms to a communication protocol in the network so that the request can be transported over the network from the computing device, see Fay (col.5 lines 55-67, col.6 lines 5-18, col.8 lines 64-67, and col.9 lines 1-5).

8. As to claim 7, Fay teaches a method of claim 6, wherein the network is the Internet and the communication protocol is Hypertext Transfer Protocol (HTTP), see Fay (col.8 lines 64-67, col.9 lines 1-5).

9. As to claim 8, Fay teaches a method of claim 4, wherein the characteristics of the 3D face model include 3D positions of pupils and a nose profile of the 3D face model in reference to the 3D reference frame, see Fay (col.6 lines 4-35, col.5 lines 20-25, col.7 lines 45-67, and col.8 lines 45-63).

10. As to claim 9, Fay teaches a method of claim 1, wherein the default position is either an "On" position or an "Off" position; and wherein the "On" position is to place the 3D representation of the glasses onto the 3D face model in accordance with the characteristics of the 3D face model, and the "Off"

position is to place the 3D representation of the glasses off and in front of the 3D face model in accordance with the characteristics of the 3D face model, see Fay (col.6 lines 1-18, col.7 lines 1-18).

11. As to claim 10, Fay teaches a method of claim 1, wherein the requesting of the 3D face model comprises uploading the 3D face model from a known location by the user, see Fay (col.7 lines 59-67, col.8 lines 1-20).

12. As to claim 11, Fay teaches a method of claim 10, wherein the known location is a computing device that stores the 3D face model, or is used to generate the 3D face model, see Fay (col.7 lines 59-67, col.8 lines 1-20).

13. As to claim 12, Fay teaches a method for commercializing pairs of eyeglasses over a network, the method comprising, see Fay (col.2 lines 50-60): displaying an interactive platform received from the network, see Fay (col.4 lines 64-67, and col.5 lines 1-7), wherein the interactive platform includes respective displays of the pairs of eyeglasses, see Fay (col.6 lines 18-34, col.8 lines 64-67, and col.9 lines 1-4); importing into the interactive platform a 3D face model of a user, see Fay (col.5 lines 7-20, col.8 lines 6-20); placing a 3D representation of one of the pairs of eyeglasses onto 3D face model when the one of the pairs of eyeglasses is selected, see Fay (col.5 lines 55-67, col.8 lines 30-63).

14. As to claim 13, Fay teaches a method of claim 12, wherein the displaying of the interactive platform comprises: generating a request including an address identifying a web site hosted by an eyeglass business; and sending the request over the network, see Fay (col.5 lines 55-67, col.6 lines 5-18, col.8 lines 64-67, and col.9 lines 1-5).

15. As to claim 14, Fay teaches a method of claim 13, wherein the network is the Internet; and wherein the request conforms substantially to Hypertext Transfer Protocol (HTTP), see Fay (col.8 lines 64-67, col.9 lines 1-5).



16. As to claim 15, Fay teaches a method of claim 13, wherein the importing of the 3D face model comprises: taking at least one image of the user; and activating a 3D modeling application to generate the 3D face model from the at least one image, see Fay (col.5 lines 1-24).

17. As to claim 16, Fay teaches a method of claim 15, wherein the importing of the 3D face model further comprises determining characteristics of the 3D face model with respect to a 3D reference frame, see Fay (col.5 lines 7-24, col.7 lines 45-58, col.8 lines 46-63).

18. As to claim 17, Fay teaches a method of claim 16, wherein the characteristics of the 3D face model include 3D positions of pupils and a nose profile of the 3D face model in reference to the 3D reference frame, see Fay (col.6 lines 4-35, col.5 lines 20-25, col.7 lines 45-67, and col.8 lines 45-63).

19. As to claim 18, Fay teaches a method of claim 15, wherein the placing of the 3D representation of one of the pairs of eyeglasses onto 3D face model comprises: placing the 3D representation of the glasses onto a default position with respect to the 3D face model in accordance with the characteristics thereof, see Fay (col.5 lines 55-67, col.8 lines 30-63).

20. As to claim 19, Fay teaches a method of claim 18, wherein the default position is either an "On" position or an "Off" position; and wherein the "On" position is to place the 3D representation of the glasses onto the 3D face model in accordance with the characteristics of the 3D face model, and the "Off" position is to place the 3D representation of the glasses off and in front of the 3D face model in accordance with the characteristics of the 3D face model, see Fay (col.6 lines 1-18, col.7 lines 1-18).

21. As to claim 20 Fay teaches a method of claim 12 further comprising providing a relative interaction between the 3D presentation of the glasses and the 3D face model, see Fay (col.8 lines 1-63, col.5 lines 7-20, and col.5 lines 55-67).

22. As to claim 21, Fay teaches a method of claim 12 further comprising providing a view of the 3D face model with the 3D representation of the glasses on from a chosen perspective, see Fay (col.8 lines 30-40).

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23. As to claim 22, Fay teaches a method for commercializing pairs of eyeglasses over a network, the method comprising: displaying an interactive platform received from the network, see Fay (col.4 lines 64-67, and col.5 lines 1-7), wherein the interactive platform includes at least two views, a first view and a second view, each of the two views receiving a 3D face model provided by a user, see Fay (col.5 lines 1-24); and placing a 3D representation of one of the pairs of eyeglasses onto the 3D face model in the first view and placing a 3D representation of another one of the pairs of eyeglasses onto the 3D face model in the second view so that the user can appreciate any differences between the two views, see Fay (col.5 lines 55-67, col.6 lines 1-54, and col.8 lines 30-63).

24. As to claim 23, Fay teaches a method of claim 22, wherein the interactive platform further includes a panel comprising a plurality of functional buttons, at least some of the buttons provided to assist the user to spatially adjust either the one of the pairs of eyeglasses or the another one of the pairs of eyeglasses with respect to the 3D face model, see Fay (col.7 lines 45-67, col.8 lines 1-67).

25. As to claim 24, Fay teaches a method of claim 22, wherein the interactive platform further includes a panel comprising a plurality of functional buttons, at least some of the buttons provided to retrieve position information of either the one of the pairs of eyeglasses or the another one of the pairs of eyeglasses, where in the position information can be applied to a newly selected pair of eyeglasses, see Fay (col.7 lines 45-67, col.8 lines 1-67).

26. As to claim 25, Fay teaches a system for commercializing pairs of eyeglasses over a network, the system comprising: a client-computing device including a display screen, executing a browsing application and coupled to a data network, see Fay (col.5 lines 55-67); a server computing device operated by an eyewear business, the server computing device accessing a database of the pairs of eyeglasses, see Fay (col.5 lines 1-55 col.6 lines 1-20); and wherein a user of the client computing device enters an IP address identifying the server computing device and sends out a specification of a selected pair of the pairs of eyeglasses after a data link is established between the client and server computing

devices, see Fay (col.6 lines 1-67); wherein the client computing device subsequently displays an interactive try-on platform in which a 3D face model and a 3D representation of the selected pair of eyeglasses are displayed, see Fay (col.6 lines 1-67); and wherein the user is able to virtually place the selected pair of eyeglasses on or off the 3D face model, see Fay (col.6 lines 1-18, col.7 lines 1-18).

27. As to claim 26, Fay teaches a system of claim 25, wherein the 3D face model is uploaded into the platform from a location known to the user, see Fay (col.7 lines 59-67, col.8 lines 1-20).

28. As to claim 27, Fay teaches a system of claim 26, wherein the location known to the user includes a computing device that stores the 3D face model, or is used to generate the 3D face model, see Fay (col.7 lines 59-67, col.8 lines 1-20).

29. As to claim 28, Fay teaches a system of claim 27, wherein the computing device is either one of the client or the server computing devices, see Fay (col.7 lines 59-67, col.8 lines 1-20).

30. As to claim 29, Fay teaches a software product for commercializing pairs of eyeglasses over a network, the software product executable on a computing device and comprising: program code for providing an interactive platform that can be displayed on a computing device, see Fay (col.4 lines 64-67, and col.5 lines 1-7); program code for requesting a 3D face model from a user; program code for determining characteristics of the 3D face model with respect to a 3D reference frame, see Fay (col.5 lines 7-20, col.8 lines 6-20); program code for retrieving a 3D representation of a pair of eyeglasses when a request identifying the pair of eyeglasses is received over the network, see Fay (col.6 lines 18-34, col.8 lines 64-67, and col.9 lines 1-4); and program code for placing the 3D representation of the glasses onto a default position with respect to the 3D face model in accordance with the characteristics thereof, see Fay (col.5 lines 55-67, col.8 lines 30-63).

31. As to claim 30, Fay teaches a software product of claim 29 further comprising: program code for permitting a relative interaction between the 3D representation of the glasses and the 3D face model; and

program code for permitting a view of the 3D face model with the 3D representation of the glasses on from a chosen perspective, see Fay (col.8 lines 1-63, col.5 lines 55-67, and col.8 lines 30-40).

32. As to claim 31, Fay teaches a software product of claim 29, wherein the interactive platform includes respective displays of the pairs of eyeglasses so that the user can choose one therefrom, see Fay (col.6 lines 4-35, col.7 lines 15-45).

33. As to claim 32, Fay teaches a software product of claim 29, wherein the characteristics of the 3D face model include 3D positions of pupils and a nose profile of the 3D face model in reference to the 3D reference frame, see Fay (col.6 lines 4-35, col.5 lines 20-25, col.7 lines 45-67, and col.8 lines 45-63).

34. As to claim 33, Fay teaches a software product of claim 29, wherein the default position is either an "On" position or an "Off" position; and wherein the "On" position is to place the 3D representation of the glasses onto the 3D face model in accordance with the characteristics of the 3D face model, and the "Off" position is to place the 3D representation of the glasses off and in front of the 3D face model in accordance with the characteristics of the 3D face model, see Fay (col.6 lines 1-18, col.7 lines 1-18).

35. As to claim 34, Fay teaches a software product of claim 29, wherein the program code for requesting of the 3D face model comprises program code for uploading the 3D face model from a known location by the user, see Fay (col.7 lines 59-67, col.8 lines 1-20).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gao et al. US Patent No. (6,095,650) Interactive eyewear selection system.
- Saigo US Patent No. (6,142,628) Eyeglass try-on simulation system.
- Soatto, Stefano WO No. (01,32074) system for selecting and designing eyeglass frames.

- Weaver, Christopher WO No. (00,77744) method and system for a computer-rendered three-dimensional mannequin.
- Ellis, Peter, R. WO No. (00,49544) product configuration display and method.

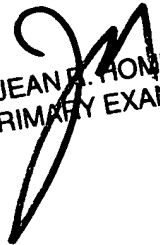
***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A Shaawat whose telephone number is (703) 605-1372. The examiner can normally be reached on Monday-Friday (8:30am to 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jean R Homere can be reached on (703) 308-6647. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mussa Shaawat  
Examiner  
August 16, 2004

  
JEAN R. HOMERE  
PRIMARY EXAMINER